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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,505	07/08/2003	Jean-Luc Collet	FR920020050US1	9234

45095 7590 12/14/2005

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EXAMINER

BOTTS, MICHAEL K

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/615,505	Applicant(s) COLLET ET AL.	
	Examiner Michael K. Botts	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/9/03, 7/12/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This document is the first Office Action on the merits. This action is responsive to the following communications: The Non-Provisional Application, which was filed on July 9, 2003, and a Status Inquiry, which was filed on July 12, 2005.

It is noted that a claim of priority under 35 U.S.C. 119 has been made to foreign application 02368077.0 filed in the European Patent Office on July 11, 2002, and it is noted that an English language copy of that application has been filed in this case.

2. Claims 1-10 have been examined, with claim 1 being the independent claim.
3. Claims 1-10 are rejected.

The Specification

4. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of U.S. filed applications in the specification should also be updated where appropriate.

Claims Rejections – 35 U.S.C. 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1-8** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was

not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Dependent claim 9 claims a “system” to do the “method” of claim 1 and is therefore an evidence claim establishing that claims 1-7 claim a “method” without a “system.” The specification does not enable one skilled in the art to make or practice such a method without a system.

Claim Rejections – 53 U.S.C. 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Dependent claim 2** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 is not further limiting of its independent claim. Claim 1 cites a limitation including a “file format profile.” Claim 2 claims the creation of “at least one file format profile.” The prior creation of the “file format profile” is inherent in the fact that it already exists.

7. **Dependent claims 9 and 10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35

U.S.C. 112, second paragraph. See, *Ex Parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). See also, MPEP 2173.05(p).

Regarding **dependent claim 9**, it is an improper hybrid claim. Claim 9 depends from claim 1. Claim 9 purports to be a system for performing the method of claim 1. As a result, claim 9 is directed to neither a “system” nor a “method.”

Regarding **dependent claim 10**, it is an improper hybrid claim. Claim 10 depends from claim 1. Claim 10 purports to be a “computer program product stored on a computer usable medium” for performing the method of claim 1. As a result, claim 10 is directed to neither a “computer program product” nor a “method.”

Claim Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Independent claim 1** is rejected under 35 U.S.C. 101 because it lacks patentable utility. Claim 9 is an evidence claim that claim 1, and its dependent claims 2-8, are non-statutory as claiming a pure method without a tangible embodiment, pure steps without form, and therefore lacking in utility.

9. **Dependent claims 9 and 10** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 4 depends from independent claim 1. In their relation to independent claim 1, dependent claims 9 and 10 embrace or overlap different statutory classes of invention set forth in 35 U.S.C. 101, which is drafted so as to set forth the statutory classes of invention in the alternative only. See, *Ex Parte Lyell*, 17 USPQ2d 1548, 1551 (Bd. Pat. App. & Inter. 1990). See also, MPEP 2173.05(p).

Regarding **dependent claim 9**, it is an improper hybrid claim. Claim 9 depends from claim 1. Claim 9 purports to be a system for performing the method of claim 1. As a result, claim 9 is directed to neither a "system" nor a "method."

Regarding **dependent claim 10**, it is an improper hybrid claim. Claim 10 depends from claim 1. Claim 10 purports to be a "computer program product stored on a computer usable medium" for performing the method of claim 1. As a result, claim 10 is directed to neither a "computer program product" nor a "method."

Claims Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-10** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Khoyi, et al. (U.S. Patent 5,303,379) [hereinafter "Khoyi"].

Regarding **independent claim 1**, Khoyi states:

A method for formatting a source text file to be imported into a spreadsheet file comprising the steps of:

a) selecting a file format profile to be associated to the source text file, the file format profile including at least one identifier with a corresponding formatting instruction;

(See, Khoyi, col. 13, lines 36-37, stating: "Document objects represent text and associated formatting information." See also, Khoyi, col. 73, line 11 through col. 74, lines 2, teaching functions for text handling, including to set attributes and change fonts. See also, Khoyi, col. 27, lines 20-36, teaching a resource file with a customization file with a customization ID and a resource file with a customization ID.)

b) creating a source-format link between the source text file and the selected file format profile;

c) importing the source text file into the spreadsheet file;

d) creating a location link between the imported source text file and its location into the spreadsheet file; and

(See, Khoyi, col. 13 line 32 through col. 22, line 15, teaching "encapsulation" and "linking," whereby text to be incorporated in an object of a different data type,

specifically including a spreadsheet, is incorporated via links between the text and “link markers” within the other data type.”)

e) applying the selected file format profile to the imported source text file by using the source-format link and the location link.

(See, Khoyi, col. 19, lines 50-51, stating: “Linking makes data from a child object appear in a parent object.”)

Regarding **dependent claim 2**, Khoyi states:

The method of claim 1 further comprising before step a) a step of creating at least one file format profile including at least one identifier with a corresponding formatting instruction.

(See, Khoyi, col. 27, lines 20-36 teaching a customization table including combinations of resource ID, resource file, and customization ID.)

Regarding **dependent claim 3**, Khoyi states:

The method of claim 2 further comprising a step of storing the created at least one file format profile into a file format profile database.

(See, Khoyi, col. 60, lines 5-37, teaching the creation of a User Profile to store the customized version of a resource.)

Regarding **dependent claim 4**, Khoyi states:

The method of claim 1 further comprising after step a) the step of modifying the selected file format profile.

(See, Khoyi, col. 19, lines 50-53, teaching modification of the file format profile as a child object. See also, Khoyi, col. 73, lines 19-25, teaching a set attributes function to edit text attributes.)

Regarding **dependent claim 5**, Khoyi states:

The method of claim 4 further comprising a step of storing the modified selected file format profile into the file format profile database.

(See, Khoyi, col. 60, lines 5-37, teaching the creation of a User Profile to store the customized version of a resource. See also, Khoyi, col. 60, lines 5-37, teaching the creation of a User Profile to store the customized version of a resource.)

Regarding **dependent claim 6**, Khoyi states:

The method of claim 1 further comprising after step d) a step of storing the location link into a spreadsheet user profile database.

(See, Khoyi, col. 19, line 45 through col. 22, line 15, teaching linking. See also, Khoyi, Figure 5, and col. 30 line 34 through col. 31, line 19, teaching a link table.)

Regarding **dependent claim 7**, Khoyi states:

The method of claim 1 wherein the spreadsheet file is created by a spreadsheet program.

(It is inherent that a spreadsheet file in an electronic document is created by a spreadsheet program. See, Khoyi, col. 13, line 44 and col. 14, line 11, teaching spreadsheet programs.)

Regarding **dependent claim 8**, Khoyi states:

The method of claim 1 further comprising after step e) a step of deleting the location link.

(See, Khoyi, col. 31, lines 12-15, teaching "Delete Flag" to delete a link.)

Regarding **dependent claim 9**, Khoyi states:

A system comprising means for processing the steps of claim 1.

(Claim 9 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **dependent claim 10**, Khoyi states:

A computer program product stored on computer usable medium, comprising computer readable program means for causing a computer to perform a method according to claim 1.

(Claim 10 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

11. It is noted that citations to specific, pages, columns, lines, or figures in the prior art references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Conclusion

12. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

Khoyi, et al. (U.S. Patent 5,634,124), teaching the invention claimed.

Khoyi, et al. (U.S. Patent 5,421,015), teaching the invention claimed.

Khoyi, et al. (U.S. Patent 5,421,012), teaching the invention claimed.

San Soucie, et al. (U.S. Patent 5,369,778), teaching the invention claimed.

Koss (U.S. Patent 5,231,577), teaching changing character attributes in spreadsheet cells.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday Thru Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB

William G. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
12/11/2005